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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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09/981,983

10/19/2001

Yasuhiro Iwamura

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04/21/2008

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ALEXANDRIA, VA 22314

EXAMINER

GREENE, DANIEL LAWSON

ART UNIT

PAPER NUMBER

3694

NOTIFICATION DATE

DELIVERY MODE

04/21/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 09/981,983 | Applicant(s) IWAMURA ET AL. | |
| | Examiner DANIEL L. GREENE | Art Unit 3694 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-6 and 10-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-6 and 10-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/29/04, 1/7/05, 6/6/07, 2/25/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Examination of this application was suspended by applicant's request received 8/5/2005 for the purpose of conducting a cooperative experiment to provide results supporting the operability of applicant's invention in an attempt to overcome the 35 USC 101 and 112 rejections set forth in sections 3-7 of the Final Office action mailed 7/7/2004. Applicant submitted subsequent requests for suspension on 4/4/2006, 11/08/2006, and 6/6/2007 which were granted. On 2/25/2008, applicant submitted a FIFTH requested for suspension, which was denied on 3/18/2008.
2. Prosecution of this application is no longer suspended and an action on the merits of claims 1, 4-6 and 10-16 follows.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on 1/7/2005 and 8/5/2005 have been entered.

Information Disclosure Statement

4. The IDSs received 3/29/04, 1/7/05 (DUPLICATE OF THAT RECEIVED 3/29/04) 6/6/2007 and 2/25/2008 have been considered and are attached to the instant

communication. The two German references have NOT been considered because the English abstract does NOT disclose enough specificity to allow one to ascertain the relevance to the instant invention AND no explanation was provided by applicant as to their relevance. Per MPEP 609;

“A concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language. The concise explanation may be either separate from applicant’s specification or incorporated therein.”

Response to Arguments

5. Applicant's arguments filed 1/7/2005 have been fully considered but they are not persuasive.

6. Applicant has been given more than two years to supply the Office with evidence in support of the invention. No such clear and convincing evidence has been provided. This supports the Examiners contentions that Applicant’s invention is drawn to the theory of “cold fusion” as there is no ability to reproduce or provide such proof of operability to either the scientific community or the Patent Office itself.

7. **As admitted by applicant, the invention is based upon a theory and/or theoretical framework.** All of applicant's arguments are considered as being directed towards an unproven scientific principle and as such are moot. See MPEP 706.03(a).1.C. wherein it is understood that applicant’s tangible structure is not the essence of the theoretical framework because applicant discloses the theoretical framework is applicable to various structures.

8. All rejections and objections from the previous Office action mailed 7/7/2004 are maintained and incorporated herein by reference.

9. Applicant's continued arguments that the instant invention is not related to cold fusion are, as previously explained, untenable. Applicant has not set forth clear and convincing evidence that the instant invention is NOT related to cold fusion, nor that the invention functions as claimed. It is considered that the title of the invention, Applicant's responses to the Examiners contentions as well as the specification set forth that the invention is directed towards a theory of "a nuclide transmutation device". As the Examiner has repeatedly pointed out, the nuclide transmutation described within the specification and claims is directed towards "fusion" that does not occur at the current scientifically accepted temperatures known to facilitate fusion and ergo it is considered "cold fusion". That is, if the fusion (transmutation) does not occur above or around four million degrees then it is considered "cold fusion". Applicant's nuclide transmutation device **is considered cold fusion**. Applicant cannot continue to properly argue the contrary.

10. The Examiner has carefully and completely considered applicant's arguments and documents submitted on 2/25/08, 6/6/2007, 1/7/2005, etc. but these arguments and document are not persuasive in overcoming the totality of the Examiners concerns and contentions.

11. Indeed, it may be considered that Applicant has failed to put forth a good faith response to the previous Office actions as MANY of the Examiners concerns have yet to be satiated.

For example applicant states in said 1/7/2005 response;

“...along with Exhibit A published by the present inventors, Applicants have submitted Exhibit B showing the study conducted and authored by two other researchers and Exhibit C showing the replication study conducted and authored by three university researchers at Osaka University together with only one of the inventors. Accordingly, it is respectfully submitted that the reproducibility did not occur only in "one's own lab," and that Applicants' assertion of utility cannot be dismissed without any "logic underlying the assertion is seriously flawed" or "facts upon which the assertion is based are inconsistent with the logic underlying the assertion" or simply because the Examiner only suspects "systematic errors" based on the co-authorships in the studies of Exhibits A-C. Applicants therefore respectfully request that the rejections under 35 U.S.C. § 101 and § 112, first paragraph, be withdrawn.”

Response: Applicant has failed to appreciate the lengthy discussions held within the first 20 pages of both office actions mailed 7/7/2004 and 10/28/2003. Therewithin lies the “logic” applicant alleges has not been provided. The fact that one of the inventors is present within each of the documents brings into question the validity of the documents. That is, the inventor himself may be introducing the systematic error or some other anomaly that the others may or may not have observed. It is immaterial that other laboratories replicated the results when one of the inventors had the ability to alter the results of the experiments. Again, no third party verifiable evidence has been submitted in support of the invention. Accordingly, the Examiners contentions are considered correct.

12. Applicant has failed to address how the invention is different from the prior art made of record. Again, applicant has provided NO VERIFIABLE EVIDENCE that he has succeeded where so many others have failed, i.e. in inventing a fusion (transmutation) device that operates below the currently understood temperatures required for fusion.

13. Applicant has failed to review the prior Office actions and respond in kind to each and every contention raised therein. Applicant has failed to prove a demarcation between the invention and “cold fusion” as explained in the previous Office actions

14. Again, Applicant's 1/7/2005 submission as well as the subsequent IDS submissions are insufficient in overcoming the Examiners contentions set forth in the previous Office actions.

15. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

16. ***Claim Rejections - 35 USC § 112, 35 USC § 101, 35 USC § 102 and 35 USC §***

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a. Claims 1, 4-6, and 10-16 are rejected for the same reasons set forth in the previous Office action mailed 7/7/2004. That is, said rejections are maintained and incorporated herein by reference. Since no new matter has been added to the application, and the Examiner has previously explained the 112/101 issues surrounding the specification, drawings and claims, the claims are rejected for at least the same reasons/issues.

b. It is considered that since applicant is unable to overcome the 35 USC 101 rejection regarding operability that any further comments on the other rejections of record are unnecessary. However, regarding the 35 USC 102 and 103 rejections, the claims still read on the references as explained in previous Office actions. Applicant has not amended the claims in any identifiably patentable manner that overcomes the art of record. Regarding applicant's

allegation that Iwamura does NOT disclose pressure regions, see for example, figures 3b and 4b as well as the abstract which discloses a vacuum container. Clearly when something at normal atmospheric pressure is placed in a vacuum container and the container is pumped down to a vacuum, there will be areas of higher pressure within that something as the pressure within that something attempts to equalize with the lower pressure of the vacuum chamber. Accordingly Iwamura reads on the claimed invention

Conclusion

17. NOTE that this action as well as previous Office actions sustain and maintain rejections from other previous Office actions.

18. In that regard, any Appeal Brief would need to be directed to ALL of the contentions/objections and rejections not previously withdrawn or obviated and written to address ALL cumulative issues previously presented and currently maintained.

19. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

20. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL L. GREENE whose telephone number is (571)272-6876. The examiner can normally be reached on Mon-Thur.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3694

22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. L. G./
Examiner, Art Unit 3694
2008-04-13

/Mary Cheung/
Primary Examiner, Art Unit 3694